## REMARKS

The Office Action of December 17, 2003 provisionally rejected claims 1, 3-4, 7-
12, 14, 16-17 and 21 under the judicially created doctrine of obviousness-type double
5    patenting over co-pending application no. 09/436,704. Claim 11 was objected to.
Further, claims 1-3, 5-12 and 14-21 were rejected under Section 103(a) as unpatentable
over Shiota in view of Lockhart (Application Serial No. 2002/0103697), Johnson (USPN
6,052,670) and Hartman (USPN 5,960,411). Claim 4 was rejected under Section 103(a)
as unpatentable over Shiota/Lockhart/Johnson/Hartman and Tackbary (USPN 6,092,054).
10   Claim 13 was rejected as unpatentable over Shiota/Lockhart/Johnson/Hartman and
Official Notice.

The Obviousness-Type Double Patenting Rejection

A Terminal Disclaimer is submitted herewith. Withdrawal of the Rejection is
15   requested.

The Section 112 Rejection/Objection

In response, a terminal disclaimer is submitted herewith. Claim 11 has been
amended. Withdrawal of the Section 112 rejection and the objection is requested.
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The Section 103 Rejections

Claims 1-3, 5-12 and 14-21 were rejected under Section 103(a) as unpatentable
over Shiota in view of Lockhart, Johnson and Hartman. Shiota relates to a network
photograph service system with at least one laboratory server which has communication
25   ability via a network and is installed in a laboratory having a picture printer, and a center
server installed in a service center which receives a printing service order via the
network. The center server carries out processing including the steps of storing a picture
recorded by a customer of each laboratory as digital image data, making the digital image
data accessible on the network, selecting one laboratory to output a print among the

laboratories in response to order information transferred from the customer via the network, and providing a printing service requested by the order to the customer by transmitting instructing information to the laboratory server installed in the selected laboratory.

5          The Office Action acknowledged that Shiota does not expressly disclose that the images are directly loaded by a user when generating the card, but noted that

> However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user to be included in the said postcard and page 4 paragraph 062, " ... the user is allowed to upload an image using a web interface (e.g., region 302 of the exemplary web page shown in Fig. 3). That is, the user clicks on a "Browse" button 306 to select a graphical image (e.g., a JPG image) that resides on the user system hard drive or network neighborhood. The user then initiates uploading the image (button 308), and the image data is transferred to mail service computer 110. Such methods for uploading files are known in the art.
>
> In view of Lockhart, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota to incorporate the Lockhart's teachings of uploading images directly by the user because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source as explicitly suggested in Lockhart (see at least page 4, paragraphs 0050-0053, " ..Where appropriate (i.c., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser
>
> In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online....,a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. For example, the images may be located in a database 111 or other storage medium associated with mail service computer 110..."

Applicants traverse the comparison. First, Lockhart (filed on April 6, 2000) is not prior art to the instant case, which claims priority date of 11/9/1999. Lockhart cites as

35    priority to two provisional applications, but Applicants cannot tell whether the provisional applications contained the subject matter asserted in the Office Action. A copy of each Lockhart provisional application is requested.

Moreover, Lockhart at best shows a system that emails images using a web interface. Specifically, Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is

5 generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail

10 item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

15 Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. Lockhart points in the opposite direction to the claimed element of "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single

20 transaction sequence". <u>Hence, the combination is improper as Lockhart teaches away from the invention.</u>

Further, the Office Action acknowledged that

Shiota in view of Lockhart as applied to claim 1 does not expressly disclose receiving a single order for the plurality of recipients. However, in the

25 field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Johnson discloses receiving a single order for the plurality of recipients (see at least FIG.16 and col.22, lines 6062, " Customer has a "contains by value" relationship with the Order class. In other words, each customer may have one or more orders, and each order may have multiple ship

30 addresses and multiple order items ". Note: each order having multiple ship addresses corresponds to receiving order for plurality of recipients in a single transaction). In view of Johnson, it would have been obvious to a person of an

ordinary skill in the art at the time of the applicant's invention to have modified
Shiota in view of Lockhart as applied to claim 1 to incorporate the Johnson's
teachings of receiving a single order for a plurality of recipients because it will
reduce the number of purchaser interactions needed to place orders for different
5      recipients and thereby making it convenient and faster for the user to have the
system receive one order for all the recipients.

Applicants again traverse the rejection. Johnson relates to an object oriented
framework mechanism that provides a straightforward and convenient way to implement
10    an electronic catalog by providing an infrastructure that embodies the steps necessary for
a framework consumer to define an electronic catalog by extending the framework to fit a
particular electronic catalog environment.

The combination of Johnson is improper since Johnson's catalog system is not
required in a system that receives "a single card order specifying a plurality of recipients
15    and, for each specified recipient, a set of one or more images directly uploaded by a user
associated with that recipient, wherein the single card order is completed in a single
transaction sequence." The cards in the card orders are created by the user using image
data uploaded by the user. The electronic catalog system in Johnson would fail to
combine with Shiota/Lockhart to produce the present invention system because the
20    electronic catalog is not capable of receiving image data for a user to create a card for a
card order. In summary, the combination is improper as Johnson teaches away from the
invention.

Hence, the combination would be inoperative or unnecessary because the
customer has the data for the item and is simply placing a single card order specifying a
25    plurality of recipients and, for each specified recipient, a set of one or more images
directly uploaded by a user associated with that recipient, wherein the single card order is
completed in a single transaction sequence. One skilled in the art would not look to
Lockhart or Johnson since catalogs are more appropriate with standardized products not
produced by the customer.

30    Moreover, the combination still does not show receiving a single card order
specifying a plurality of recipients and, for each specified recipient, a set of one or more

images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. The Office Action acknowledged that

Shiota in view of Lockhart further in view of Johnson as applied to claim 1 does not expressly suggest receiving order in a single transaction sequence. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Hartman discloses receiving an order in a single transaction sequence (see at least col.2, lines 50-57, " An embodiment of the present invention provides a method and system for ordering an item from a client system. The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item..."'). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart and further in view of Johnson as applied to claim 1 to incorporate the Hartman's teachings of receiving an order in a single transaction sequence because the single transaction sequence ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

Hartman relates to a method and system for placing an order to purchase an item via the Internet. The order is placed by a purchaser at a client system and received by a server system. The server system receives purchaser information including identification of the purchaser, payment information, and shipment information from the client system. The server system then assigns a client identifier to the client system and associates the assigned client identifier with the received purchaser information. The server system sends to the client system the assigned client identifier and an HTML document identifying the item and including an order button. The client system receives and stores the assigned client identifier and receives and displays the HTML document. In response to the selection of the order button, the client system sends to the server system a request to purchase the identified item. The server system receives the request and combines the purchaser information associated with the client identifier of the client system to generate an order to purchase the item in accordance with the billing and shipment information whereby the purchaser effects the ordering of the product by selection of the order button.

The combination of Shiota/Lockhart/Johnson/Hartman is improper because Lockhart and Johnson teach away from the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card

5   order is completed in a single transaction sequence, as discussed above. Even though Hartman shows a single action such as clicking a mouse button that a purchaser is to perform to order the identified item, there is no suggestion in Shiota, Lockhart, Johnson or Hartman to form system that receives "a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded

10  by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence." There is no suggestion to combine, and the rejection is simply using hindsight taught by the instant invention to combine the references in the specific manner of claim 1.

Applicant notes that the present rejection does not establish *prima facie*

15  obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Shiota reference or in the knowledge generally available to one

20  of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*,

25  180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

First, Applicant notes that the references fail to teach or suggest all the claim limitations of the independent claims. In particular, independent claim 1 recites receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient,

5    wherein the single card order is completed in a single transaction sequence; for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients. The receiving a single card order specifying a plurality of

10   recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence is not reasonably taught or suggested in the cited art reference.

Secondly, Applicant notes that no motivation or suggestion, either in the cited art

15   reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Shiota reference so as to produce the claimed invention. Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a

20   *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in the references, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of the independent claims. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a

25   determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single

5      card order is completed in a single transaction sequence, *prima facie* obviousness of the independent claims and those dependent therefrom has not been established. As such, it is respectfully requested that the § 103(a) rejections be withdrawn and the claims be allowed.

If for any reason the Examiner believes that a telephone conference would in any

10    way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

/Bao Tran

15                                                            Reg. 37,955